

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:

Leslie DOTSON

Appl. No.: 10/716,178

Filed: November 19, 2003

For: **Foldable Keyboard Assembly**

Confirmation No.: 3809

Art Unit: 2876

Examiner: To Be Assigned

Atty. Docket: 2219.0030001

Petition Under 37 C.F.R. § 1.47(b)

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the requirements of 37 C.F.R. § 1.47(b) and M.P.E.P. § 409.03(b), Petitioner has filed herewith the following documents:

- (1) A copy of a declaration for patent application executed by Mr. John H. McAlpine, Executive Vice President and Chief Financial Officer of Targus, Inc., on behalf of non-signing inventor Leslie Dotson;
- (2) A copy of a Confidentiality Agreement between non-signing inventor Leslie Dotson and Targus, Inc.; and
- (3) Statement of Facts In Support Of Filing On Behalf Of Non-Signing Inventor Under 37 C.F.R. § 1.47(b) from Thomas C. Fiala, Esq.

The declaration for patent application has been signed on behalf of non-signing inventor Leslie Dotson ("Mr. Dotson") by Mr. John H. McAlpine, Executive Vice President and Chief Financial Officer of Targus, Inc. ("Targus"). The invention was made by Mr. Dotson while employed by Targus. Further, Mr. Dotson agreed in writing to assign the above-referenced application to Targus in Section 4(e) of a Confidentiality Agreement between Mr. Dotson and Targus. A copy of the Confidentiality Agreement is attached hereto.

Since Mr. Dotson agreed in writing to assign the subject application to Targus, Targus is therefore justified to make application for patent on behalf of Mr. Dotson. The Declaration for patent application has not been executed by Mr. Dotson. Petitioner submits that the declaration for patent application signed by Mr. John H. McAlpine should be considered. *See* M.P.E.P. § 409.03(b)(A). The declaration for patent application also indicates the last known address of the non-signing inventor as required by M.P.E.P. § 409.03(b)(D).

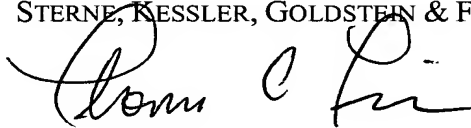
Petitioner further submits that Mr. Dotson's agreement to assign the above-referenced application, as set forth in the Confidentiality Agreement between Mr. Dotson and Targus, establishes Petitioner's propriety interest and title in the application.

A provisional application directed to the invention disclosed and claimed in the above-referenced application was filed on November 19, 2002. The filing of the present application on November 19, 2003, was necessary to preserve Targus's rights in this invention.

The Statement of Facts In Support Of Filing On Behalf Of Non-Signing Inventor Under 37 C.F.R. § 1.47(b) from Thomas C. Fiala, Esq., provides proof of the pertinent facts that Mr. Dotson will not sign the declaration for patent application. Petitioner therefore respectfully submits that the documents and fees filed herewith satisfy all the requirements of 37 C.F.R. § 1.47(b) and M.P.E.P. §§ 409.03(b), (d), (e), (f) and (g). Accordingly, Petitioner respectfully request that the Petition Under 37 C.F.R. § 1.47(b) be granted.

Respectfully submitted,

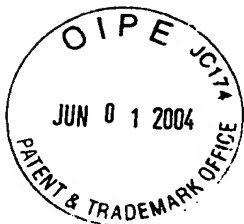
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Thomas C. Fiala
Attorney for Petitioner
Registration No. 43,610

Date: 6/1/04

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600



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**Statement Of Facts In Support of Filing On Behalf Of Non-Signing
Inventor Under 37 C.F.R. § 1.47(b)**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

I, Thomas C. Fiala, hereby declare:

1. I am making this statement of facts in support of filing on behalf of non-signing inventor under 37 C.F.R. § 1.47(b) with regard to U.S. Non-Provisional Patent Application No. 10/716,178, filed November 19, 2003, which claims the benefit or Provisional U.S. Patent Application No. 60/427,913, filed November 19, 2002 (hereinafter referred to as the "patent application").

2. I am registered to practice before the U.S. Patent and Trademark Office (USPTO) with Reg. No. 43,610.

3. I am employed at the law firm of Sterne, Kessler, Goldstein & Fox, P.L.L.C. (hereinafter "SKGF"), 1100 New York Avenue, N.W., Washington, D.C. 20005-3934.

4. Mr. Leslie Dotson ("Mr. Dotson") is the sole inventor named in the patent application. His last known address as of June 1, 2004, is as follows:

1919 West Coronet Avenue, #30, Anaheim, California 92801.

5. The invention was made by Mr. Dotson during the time Mr. Dotson was an employee with Targus, Inc. ("Targus"), a New York corporation, and is pertinent to the business of Targus. During his employment, Mr. Dotson agreed in writing to assign all inventions made during his employment and pertinent to the business of Targus (*see* the attached Confidentiality Agreement, Section 4(e)). Therefore, Mr. Dotson has an obligation to assign the invention to Targus.

6. Mr. Dotson is no longer employed by Targus.

7. On April 15, 2004, I sent to Mr. Dotson a package via Federal Express that included a cover letter, a copy of the above-referenced patent application for his review, and a declaration and an assignment for his execution. According to Federal Express, the package was successfully delivered on April 16, 2004.

8. On April 21, 2004, I received an e-mail from Mr. Dotson which stated as follows:

Dear Mr. Fiala,

Thank you for the letter dated April 15, 2004 from your law office. Hello this is Les Dotson, inventor of the IR keyboard. I would like to obtain more information on the patent application for my Foldable Keyboard Assembly, ref # 2219.0030001.

Can you please explain to me in detail the "Assignment" document that is referenced to Targus Group International. I would like [to] understand the reason for the assignment document as a whole.

Please send correspondence to Les Dotson at pflboi@ol.com

Thank you for your time in this matter.

Les Dotson

The return e-mail address provided with the e-mail was pflboi@aol.com.

9. On April 28, 2004, I sent a return e-mail to Mr. Dotson at pflboi@aol.com, stating, in pertinent part:

Dear Mr. Dotson:

Thank you for your e-mail. The Assignment document transfers your rights in the patent application to Targus. This is in accordance with your contractual obligation to assign to Targus all inventions pertinent to the business of Targus that you developed (either alone or in conjunction with others) during the time you were employed by Targus. Please see 4(e) of the Confidentiality Agreement that you entered into with Targus, a copy of which is attached hereto for your convenience.

The "Foldable Keyboard Assembly" patent application that we sent you falls within the scope of this paragraph. Accordingly, we request that you execute the declaration and assignment documents that we provided to you and return them to us as soon as possible.

An electronic copy of the Confidentiality Agreement between Mr. Dotson and Targus was attached to the e-mail.

10. On May 26, 2004, I sent a follow-up e-mail to Mr. Dotson since I had not received a response to our e-mail sent April 28, 2004. This e-mail stated, in pertinent part:

Dear Mr. Dotson,

Further to my e-mail of April 28, 2004, can you kindly advise us as to whether you have executed the declaration and assignment documents that we provided to you for the Foldable Keyboard Assembly patent application, and when we may expect them? Thank you.

11. As of June, 1, 2004, I still have not received a responsive communication from Mr. Dotson regarding the above-referenced patent application.

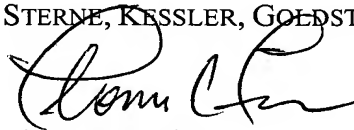
12. On October 8, 2003, Targus filed a lawsuit against Mr. Dotson in the Superior Court of California, Orange County, alleging that Mr. Dotson performed actions giving rise to at least the following causes of action against him: misappropriation of trade secrets; unfair competition; breach of contract; breach of the implied covenant of good faith and fair dealing; breach of fiduciary duty; tortious interference with contract; tortious interference with prospective economic advantage; breach of duty of loyalty; conspiracy; aiding and abetting; restitution for unjust enrichment; and accounting. This lawsuit is currently ongoing.

13. In light of the ongoing litigation between Targus and Mr. Dotson, and Mr. Dotson's failure to respond to the e-mails of April 28, 2004 and May 26, 2004, it is not anticipated that Mr. Dotson will sign a declaration for patent application for the above-referenced case.

I declare that all statements made herein of my own knowledge are true and that all statements made on information from review of the file history of the patent application are believed to be true, and further that these statements were made with the knowledge that willful false statements or the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the patent application or any patent issued thereon.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Thomas C. Fiala
Attorney for Applicant
Registration No. 43,610

Date: 6/1/04

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